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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,818	02/04/2002	James R. Hornsby	14002.01	4800

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LAW OFFICE OF RICHARD B. KLAR  
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EXAMINER

CEGIELNIK, URSZULA M

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 08/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/066,818

**Applicant(s)**

HORNSBY ET AL.

**Examiner**

Urszula M. Cegielnik

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 11 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3-17,21 and 26-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-17,21 and 26-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 31 (second instance) - 40 have been renumbered 32-41.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 36 and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 36 recites the limitation "the second trigger mechanism" in line 2. Claim 40 recites "the means for discharging a generating coherent stream of fluid" (line 1-2) and "the means for discharging a generally conical stream of fluid" (line 2-3). There are insufficient antecedent bases for these limitations in the claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Esposito (US Patent No. 4,239,129) in view of Schaeffeler et al. (US Patent No. 6,469,268).

Esposito disclose a fluid discharge mechanism (3); a plurality of light sources (9,11), located along a fluid discharge mechanism (3); and a sequential trigger (14) coupled to the fluid discharge mechanism (3) and to the light sources (9,11).

Esposito does not disclose confronting first and second switch plates slidably coupled to each other, the first and second switch plates having a longitudinal axis.

Schaeffeler et al. teach confronting first (15,18) and second (15',18') switch plates slidably coupled to each other, the first and second switch plates having a longitudinal axis (see Figure 5, for example).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide to abovementioned claimed features as taught by Schaeffeler et al., since such a modification would permit precise switch control.

Claims 3-5, 7, 8, 21, and 27-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chin-Fu (US Patent No. 4,750,641) in view of Lebensfeld et al (US Patent No. 6,302,796).

Chi-Fu discloses a fluid discharge mechanism (33); a light source (40); and a sequential trigger mechanism (18) coupled to the fluid discharge mechanism (33) and to the light source (40), the sequential trigger mechanism (18) includes first (22) and second (24) switch plates ("*pushed against*" [col. 4, lines 19-21] may be interpreted as

being slidable) slidably coupled to each other; the conductive portions of reference parts 22 and 24 enable the motor to be actuated (which is operated by battery).

Chin-Fu does not disclose a plurality of light sources; an IR transmitter and receiver.

Lebensfeld et al. disclose a plurality of light sources (74,75); Lebensfeld et al. disclose an IR transmitter (70) and receiver (14) which is (operably) coupled to a trigger mechanism (80).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide an IR transmitter and receiver as taught by Lebensfeld et al., since such a modification would provide enhanced interactive play value.

Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a plurality of light sources as taught by Lebensfeld et al., since Chin-Fu states at col. 4, lines 57-58, that such a modification would increase the entertainment value of the toy.

Claims 6, 12-17, 37, 40, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chin-Fu (US Patent No. 4,750,641) in view of Lebensfeld et al. (US Patent No. 6,302,796) and Greenberg et al. (US Patent 6,280,277)

Chi-Fu discloses a fluid discharge mechanism (33); a light source (40); and a sequential trigger mechanism (18) coupled to the fluid discharge mechanism (33) and to the light source (40), the sequential trigger mechanism (18) includes first (22) and second (24) switch plates slidably coupled to each other; means for discharging

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coherent stream of fluid (15) is independent from means for discharging conical stream of fluid (34).

Chin-Fu does not disclose an IR transmitter and receiver; and a trigger lock mechanism.

Lebensfeld et al. disclose an IR transmitter (70) and receiver (14) which is (operably) coupled to a trigger mechanism (80).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide an IR transmitter and receiver as taught by Lebensfeld et al., since such a modification would provide enhanced interactive play value.

Greenberg et al. teach a trigger lock mechanism (23).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a trigger lock mechanism as taught by Greenberg et al., since such a modification would provide protection against unintentional activation of the trigger mechanism.

Claims 12, 13, 38, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Esposito (US Patent No. 4,239,129) in view of Lebensfeld et al. (US Patent No. 6,302,796) and Greenberg et al. (US Patent 6,280,277).

Esposito discloses a fluid discharge mechanism (3); a housing (2) having a plurality of light sources (9,11) disposed along the fluid discharge mechanism (3), the housing (2) enclosing the fluid discharge mechanism (3); and a sequential trigger mechanism (14) coupled to the fluid discharge mechanism (3) and to the light sources (9,11),

Esposito does not disclose an IR transmitter and receiver; and a trigger lock mechanism.

Lebensfeld et al. teach an IR transmitter (70) and receiver (14) which is (operably) coupled to a trigger mechanism (80).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide an IR transmitter and receiver as taught by Lebensfeld et al., since such a modification would provide enhanced interactive play value.

Greenberg et al. teach a trigger lock mechanism (23).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a trigger lock mechanism as taught by Greenberg et al., since such a modification would provide protection against unintentional activation of the trigger mechanism.

Claims 9-11, 35, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 3 above, and further in view of Minoura et al. (US Patent No. 6,050,498).

Chin-Fu (US Patent No. 4,750,641) as modified by Lebensfeld et al (US Patent No. 6,302,796), lack an additional tank with trigger and purge valves.

Minoura et al. (US Patent No. 6,050,498) teach a fluid-discharge device having a plurality of tanks (2-6) with associated trigger valves (20-24), and a purge valve (67).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide additional tanks with associated trigger valves and purge

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valve as taught by Minoura et al., since such a modification would allow the toy to be played with to an extended period of time.

### ***Response to Arguments***

Applicant's arguments filed 11 May 2006 have been fully considered but they are not persuasive.

In response to Applicant's argument that Chin-Fu does not disclose a sequential trigger mechanism with confronting first and second switch plates slidably coupled to each other, the examiner submits that the first and second switch plates are slidably coupled to each other, when the trigger 18 is pressed, the free end of spring switch 22 is pushed against (i.e. in effect slides down to make contact with the terminal 24). The Examiner is entitled to read the claimed limitations in the broadest context without reading limitations from the specification into the claims.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Lebensfeld et al. shows an IR transmitter and receiver which even though used for a shooting game is nevertheless related to the device of Chin-Fu also being a shooting device, Lebensfeld



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et al. shows an enhanced level of interactivity of the shooting device which is used to supplement the interactivity of the Chin-Fu device.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Urszula M. Cegielnik whose telephone number is 571-272-4420. The examiner can normally be reached on Monday through Friday, from 5:45AM-2:15PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene L. Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Urszula M. Cegielnik  
Assistant Examiner  
Art Unit 3711

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EUGENE KIM  
SUPERVISORY PATENT EXAMINER